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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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1802/1119 10/19/93 POWERBUILT

1 1017-6534

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1802/1119

EXAMINER

MCLELLVEY, J

ART UNIT

PAPER NUMBER

1805

DATE MAILED:

11/19/93

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

BEST AVAILABLE COPY

See the attached.

Office Action Summary

Application No.
08 366,083

Applicant(s)
Pomerantz et al.

Examiner
Terry A. McKelvey

Group Art Unit
1805



X Responsive to communications filed on Aug 25, 1997

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire zero month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

X Claim(s) 1-39 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

X Claims 1-39 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code: Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received:

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1805, Examiner Terry A. McKelvey.

Election/Restriction

Applicant's election without traverse of Group I, claims 1-21, 27-28 and 36 in Paper No. 10, filed 8/25/97 is acknowledged. However, a review of the restriction requirement set forth by the previous examiner in Paper No. 8, mailed 7/22/97, resulted in the identification of two errors. First, Group II was misidentified as consisting of claims 29-32. Claims 31-32 should have been listed as a part of Group III, resulting in Group II consisting of claims 29-30 and in Group III consisting of claims 22-23, 25-26, 31-33, 35 and 37-39.

The other error was the inclusion of two patentably distinct inventions in the elected group, Group I, claims 1-21, 27-28 and 36. Therefore, it is appropriate that the applicant further elect from one of the two groups set forth below. The original

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restriction stands except as modified by the instant communication.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- IA. Claims 1-21, drawn to chimeric proteins, classified in class 530, subclass 350.
- IB. Claims 27-28 and 36, drawn to method of constructing a chimeric protein, classified in class 435, subclass 172.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group IB and Group IA are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the chimeric protein of Group IA can be made by a materially different process, linkage of DNA binding domains without use of a modeling system (e.g. random linkages of DNA binding domains), followed by identification of the binding site of the chimeric protein by selection of binding sites from a random pool of oligonucleotides.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Lisa Warren on 10/30/97 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Conclusion

Certain papers related to this application may be submitted to Art Unit 1805 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993); see 37 C.F.R. § 1.6(d). The official fax telephone numbers for the Group are 703 308-4242 and 703 305-3014.

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NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. George Elliott, can be reached on (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Terry A. McKelvey

Terry A. McKelvey
Patent Examiner
Art Unit 1805

November 16, 1997